

REMARKS

- Claims 1-162 were pending in the present application
- Claims 1-162 stand rejected

Upon entry of this amendment, which is respectfully requested for the reasons set forth below:

- Claims 1-162 will be pending
- Claims 4, 12, 124, and 125 will be amended
- Claims 1, 87, 88, 91, 99, 102, 105, 123-126, 131, 134-162 will be the only independent claims

Claim Amendments

Claims 4, 12, 124, and 125 have been amended to correct minor and obvious typographical errors identified during a review of the file. No new matter has been added by this amendment and no changes were made for any reason relating to patentability.

Section 101 Rejection

Claims 1-20, 23, 25, 27, 29-33, 35-48, 50,52, 54, 56-65, 68, 73-116, and 120-138 are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. [Office Action, page 2].

1. The Basis for Rejection

As best as Applicants understand the rejection of the claims for being directed to non-statutory subject matter, the basis for the Section 101 rejection is any or all of the following:

- (i) Claim 1 “is not limited by language to a useful, concrete and tangible application within the technological arts” [Office Action, page 2];
- (ii) “Claim 1 suffers from undue-breadth” [Office Action, page 2]; and
- (iii) Claim 1 could theoretically be performed using a pencil and paper [Office Action, pages 3-4].

To the extent the rejection under Section 101 applies a standard that requires additional criteria or otherwise departs from the requisite legal analysis under Section 101, the rejection is flawed.

2. The Claims Meet the Standard for Statutory Subject Matter

A claimed invention that produces a **useful, concrete and tangible result** constitutes statutory subject matter. *AT & T Corp.*, 172 F.3d 1352, 1356, 50 USPQ2d 1447, 1451; *State Street Bank*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601.

Applicants understand the Examiner to be asserting that none of Claims 1-20, 23, 25, 27, 29-33, 35-48, 50,52, 54, 56-65, 68, 73-116, and 120-138 produces a useful, concrete and tangible result. The Examiner, however, does not provide any reasoning as to why no such result is produced by any of those claims.

Contrary to the Examiner’s omnibus assertion, all pending claims produce a useful, concrete and tangible result. For example, independent Claim 1 includes the limitation of

providing an indication of a benefit associated with said outcome. As explained in the Specification, *providing an indication of a benefit associated with said outcome* results in a useful, concrete and tangible result – providing an indication of a benefit to which a user may be entitled. In certain disclosed embodiments, a user can use an unlock code to reveal an indication of a prize or benefit associated with an outcome (e.g., “television,” “ten-thousand dollars”). [See, e.g., page 21, lines 18-24]. Further, the *indication of a benefit associated with said outcome* may be accepted and relied upon by users and / or merchants - it is something that a user may act upon to redeem the indicated benefit.

Applicants respectfully submit that despite the Examiner’s unsupported assertion, each of Claims 1-20, 23, 25, 27, 29-33, 35-48, 50,52, 54, 56-65, 68, 73-116, and 120-138 produces a useful, concrete and tangible result. Accordingly, Applicants respectfully request that the Examiner withdraw the Section 101 rejection.

3. **“Undue Breadth” / “Pencil and Paper” is Not a Basis for Determining Statutory Subject Matter**

Applicants disagree with the Examiner’s conclusion that a claim is non-statutory if it “suffers from undue breadth” or theoretically may be performed “with pencil and paper.” Applicants note that there is **no such requirement** that something not be able to be performed using a pencil and paper in order to be statutory.

4. **Request for Clarification**

If this rejection is maintained, Applicants respectfully request an appropriate and explicit basis for the test used in rejecting the claims. Specifically, Applicants respectfully request clarification as to which of the following is the basis for the Examiner’s “undue breadth” / “no pencil and paper” test:

- (1) this test is believed to be in accordance with some section of the MPEP, or instead
- (2) this test is a formal policy of the U.S. Patent and Trademark Office.

If the basis is (1), the rejection should be withdrawn because no section of the MPEP sets forth such a test for statutory subject matter. Further, Applicants are unaware of any statute or court decision supporting this test. Although undue breadth of a claim may be addressed under “different statutory provisions” (as the Examiner notes on page 3 of the Office Action), Section 101 is not one of those statutory provisions. [See, e.g., MPEP 2173.04 (discussing only Sections 112, 102, and 103)]. Moreover, the Federal Circuit has made it clear that the only issue is whether the claimed invention produces a useful, concrete, tangible result.

Applicants note that the standard(s) (undue breadth or not performable using pencil and paper) have no basis in law.

If the basis is (2), please clarify whether the “undue breadth” / “no pencil and paper” test relies on a new statutory interpretation of 35 U.S.C. § 101 that has been adopted by the U.S. Patent and Trademark Office.

Section 103(a) Rejection

Claims 1, 87, 88, 91, 99, 102, 105, 123-126, 131, and 134-162 stand rejected under 35 U.S.C. 103(a) as being obvious over only U.S. Patent No. 5,791,991 issued to Small (hereinafter "Small").

Claims 2-86, 89, 90, 92-98, 100, 101, 103, 104, 106-122, 127-130, 132, and 133 stand rejected under 35 U.S.C. 103(a) as being obvious over Small and in view of the Examiner's Official Notice of what was "notoriously well known and expected in the art at the time of the invention."

Applicants respectfully traverse the Examiner's Section 103(a) rejections.

1. Small Does Not Suggest All of the Features of All of Claims 1-162

The Examiner asserts that even where Small "lacks explicit recitation" of a feature, it nonetheless "reasonably suggests" all of the "elements and limitations" of each of the pending Claims 1-162. [Office Action, pages 4-13]. No indication is given as to how Small suggests all feature of all claims. Applicants respectfully traverse this omnibus assertion as to what Small "suggests."

So that Applicants may best assist the Examiner with the examination of the present application, Applicants respectfully request that the Examiner clarify what features of pending Claims 1-162 are taught or suggested by Small, and provide the most relevant citations for the subject matter that the Examiner believes suggests each particular feature for all of Claims 1-162.

2. No Motivation to Modify Small

As best understood by Applicants, the Examiner asserts the following to be true with respect to all of the pending claims (Claims 1-162):

- (a) Small teaches that each specific claimed feature not explicitly disclosed in Small would provide "'a more desirable and convenient method of promoting the sale of consumer products....' (see Small col. 2, ll. 37-42)"
- (b) It would have been obvious in light of (a) to modify the Small system to provide for the specific claimed features not explicitly disclosed in Small

[Office Action, pages 4-18].

The Examiner must show that the prior art of record provides the motivation of (a) above. MPEP 2143. Further, the Examiner must show that the asserted motivation of (a) above include a teaching, suggestion, or motivation to make the proposed combination or modification of the asserted teachings of the prior art **to produce the specific features of the claimed invention**.

Applicants have carefully reviewed the Office Action issued in the present application, as well as the Small reference cited by the Examiner, without finding a motivation anywhere in the record that suggests the desirability of modifying the Small reference in any of the specific ways proposed by the Examiner.

The Examiner relies solely on the following statement in Small: "It is apparent that, with recent proliferation in personal computers, the availability of on-line services and the Internet, and the increasing popularity of match games, such as Bingo and Keno, a more desirable and

convenient method of promoting the sale of consumer products should be developed.” [Column 2, lines 37-43].

The Examiner does not provide any reasoning or support in the evidence of record as to why the stated general desirability of providing a “more desirable and convenient method of promoting the sale of consumer products” would suggest to one of ordinary skill in the art the desirability of providing any of the claimed features in the Small system. Nonetheless, the Examiner relies upon this general statement alone as teaching specifically the desirability of providing for various features of all of Claims 1-162, for example, (i) *generating an unlock code capable of unlocking said outcome* and (ii) *providing an indication of said unlock code*, as recited in independent Claim 1. Applicants respectfully traverse the Examiner’s omnibus assertion.

The Examiner’s asserted motivation amounts to a mere statement by the Examiner that the proposed modifications of Small would be advantageous, and that any advantageous modification of Small would be obvious. In short, the Examiner would have found any modification to the Small system obvious if the modification provided for “a more desirable or convenient method.” This statement does not meet the requirement of evidence of a motivation in the prior art to provide for the particular claimed features. Applicants respectfully submit that the purported motivation does not suggest any such modifications of the Small system.

Applicants respectfully submit that there is no suggestion in the prior art of record to combine the particular asserted teachings of the prior art to provide for all of the features of any of Claims 1-162. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of any of Claims 1-162.

3. Independent Claim 1

3.1. Small Does Not Teach or Suggest All the Limitations of Independent Claim 1

As best understood by Applicants, the Examiner asserts the following to be true with respect to independent Claim 1:

- (c) Small “shows” all of the features of Claim 1, including (in original FIG. 4) features of:
- *generating an unlock code capable of unlocking said outcome*
 - *providing an indication of said unlock code*

[Office Action, pages 5-6]. Applicants respectfully traverse this assertion. Applicants have carefully reviewed the Small reference cited by the Examiner, without finding a teaching or suggestion of any of the above features in (c).

Contrary to the Examiner’s assertion, the “numbers and categories (i.e., ‘6 CEREALS’...)” in FIG. 4 of Small, do not “show” or suggest *an unlock code*, much less *generating an unlock code capable of unlocking an outcome*, much less *providing an indication of an unlock code capable of unlocking an outcome*. For example, there is nothing in Small that would suggest that “6 CEREALS” (FIG. 4) is capable of unlocking anything, much less *unlocking an outcome*. The Examiner does not provide any explanation as to how the “numbers and categories” of FIG. 4 (or any portion of Small) might suggest any such features. Applicants respectfully submit that the mere depiction of a product category, as described in the Small reference, does not suggest *an unlock code capable of unlocking an outcome*.

Applicants respectfully submit that Small does not disclose all of the limitations of independent Claim 1.

3.2. No Motivation to Modify Small

As best understood by Applicants, even though the Examiner asserts that Small “shows” all of the features of independent Claim 1, the Examiner also asserts that it would have been obvious to modify the Small system in order to provide for the features in (c) above.

As discussed in Section 2 above, Small does not teach or suggest any motivation to provide specifically for those features of Claim 1.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of independent Claim 1.

4. Independent Claims 91, 105, 123-126, 131, 134-142, and 147-162

The Examiner rejects all of independent Claims 91, 105, 123-126, 131, 134-142, and 147-162 “for substantially the same reasons” as independent Claim 1. For at least the reasons stated herein with respect to independent Claim 1, Applicants respectfully submit that the Examiner has failed to establish that Small teaches all of the limitations of any of Claims 91, 105, 123-126, 131, 134-142, and 147-162, and the Examiner has also failed to establish a motivation in the evidence of record for making the proposed modifications to the Small system.

Further, Applicants respectfully submit that Small does not teach or suggest *a qualifying action, a completion of a qualifying action, associating a qualifying action with an unlock code, or associating a qualifying action with an outcome*. The Examiner does not assert otherwise, and did not address any such features in the discussion of independent Claim 1. Each of independent Claims 105, 123-126, 131, 134-138, and 147-162 recites one or more of the above features. Applicants respectfully submit that Small is devoid of a hint or suggestion of any such features, and is devoid of any suggestion of the desirability of providing for such features.

Accordingly, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to any of independent Claims 91, 105, 123-126, 131, 134-142, and 147-162.

5. Independent Claim 87

5.1. The Small Reference Does Not Teach or Suggest All the Limitations of Independent Claim 87

As best understood by Applicants, the Examiner asserts the following to be true with respect to independent Claim 87:

- (d) Small “shows” all of the features of Claim 87, including (in original FIG. 4) features of:
- *providing data representative of an outcome, said outcome associated with at least one unlock code*
 - *providing data representative of said at least one unlock code*

[Office Action, pages 5-6]. Applicants respectfully traverse this assertion. Applicants have carefully reviewed the Small reference cited by the Examiner, without finding a teaching or suggestion of any of the above features in (d).

As discussed in 3.1 above, contrary to the Examiner's assertion, the "numbers and categories (i.e., '6 CEREALS'...)" in FIG. 4 of Small, do not "show" or suggest *an unlock code*. Accordingly, Small cannot "show" or suggest *an outcome associated with at least one unlock code*, much less *providing data representative of an unlock code*. Applicants respectfully submit that Small does not disclose all of the limitations of independent Claim 87.

5.2. No Motivation to Modify Small

As best understood by Applicants, even though the Examiner asserts that Small "shows" all of the features of independent Claim 87, the Examiner also asserts that it would have been obvious to modify the Small system in order to provide for the features in (d). As discussed in Section 2 above, contrary to the Examiner's assertion, Small does not teach or suggest any motivation to provide specifically for the features of Claim 87.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness for independent Claim 87.

6. Independent Claims 88, 99, 102, and 143-146

The Examiner rejects all of independent Claims 88, 99, 102, and 143-146 "for substantially the same reasons" as independent Claim 87. Accordingly, for at least the reasons stated herein with respect to independent Claim 87, Applicants respectfully submit that the Examiner has failed to establish that Small teaches all of the limitations of any of Claims 88, 99, 102, and 143-146, and the Examiner has also failed to establish a motivation in the evidence of record for making the proposed modifications to the Small system.

Further, Applicants respectfully submit that Small does not teach or suggest *providing an indication of an unlock code associated with a promotion outcome to an intermediary*, as recited in independent Claim 99; or *providing an indication of a promotion outcome to an intermediary*, as recited in independent Claim 102. The Examiner does not assert otherwise, and did not address any such features in the discussion of independent Claim 87. Applicants respectfully submit that Small is devoid of a hint or suggestion of any such features, and is devoid of any suggestion of the desirability of providing for such features.

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to any of independent Claims 88, 99, 102, and 143-146.

7. **All Dependent Claims (Claims 2-86, 89, 90, 92-98, 100, 101, 103, 104, 106-122, 127-130, 132, and 133)**

As best understood by Applicants, the Examiner asserts the following to be true with respect to all of the dependent claims (Claims 2-86, 89, 90, 92-98, 100, 101, 103, 104, 106-122, 127-130, 132, and 133):

- (e) All of the features recited in each of Claims 2-86, 89, 90, 92-98, 100, 101, 103, 104, 106-122, 127-130, 132, and 133 were “notoriously well known and expected in the art at the time of the invention” (Examiner’s Official Notice)
- (f) It would have been obvious to one of ordinary skill in the art to modify Small in light of the Official Notice
- (g) The motivation for this modification in (f) is the same as in (a) (page 33) above

7.1. **Official Notice**

The Examiner’s rejections of all of the dependent claims (Claims 2-86, 89, 90, 92-98, 100, 101, 103, 104, 106-122, 127-130, 132, and 133) are thus based in part on unsupported general assertions of what was “notoriously well known and expected” before the time of Applicants’ invention. [Office Action, pages 6 and 8-13] Applicants respectfully traverse the Examiner’s omnibus Official Notice of the recited features of all of the dependent claims (Claims 2-86, 89, 90, 92-98, 100, 101, 103, 104, 106-122, 127-130, 132, and 133).

Applicants note that the scope of the matter of which the Examiner takes Official Notice is limited to the substantial evidence in the record for such matter. The cited Small reference does not support the Examiner’s broad assertions as to what was well known; the Examiner does not assert otherwise.

No references have been provided for any of the Examiner’s assertions. Given that the only particular information in the record thus far regarding what is considered to be in the prior art is the Examiner’s brief omnibus statement, Applicants cannot properly determine the bounds of the prior art. Accordingly, Applicants:

- (i) dispute that the subject matter asserted was “notoriously well known and expected” at the time the invention was made, and
- (ii) request a reference, for each of the dependent claims (Claims 2-86, 89, 90, 92-98, 100, 101, 103, 104, 106-122, 127-130, 132, and 133), to clarify the subject matter in more detail. MPEP 2144.03.

The Examiner’s sweeping assertions cannot be used as prior art to the present application – only the content of the references of record which are prior art to the present application may so used. “[D]eficiencies of the cited references cannot be remedied by the Board’s general conclusions about what is ‘basic knowledge’ or ‘common sense.’” In re Zurko, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); In re Lee, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

Further, Officially-Noticed subject matter cannot be used as the **basis** for a rejection under 102 or 103. Official Notice may be used, if at all, only to clarify the meaning of a reference. See, e.g., In re Ahlert, 424 F.2d 1088 (C.C.P.A. 1969) (“Typically, it is found necessary to take notice of facts which may be used to supplement or **clarify the teaching of a**

reference disclosure, perhaps to justify or explain a particular inference to be drawn from the reference teaching.”) (emphasis added).

In other words, Official Notice of what existed in the prior art is not permitted. A reference must be provided to show the scope and content of the prior art. See, e.g., *In re Ahlert*, 424 F.2d 1088 (C.C.P.A. 1969) (“Assertions of technical facts in areas of esoteric technology **must always be supported by citation to some reference** work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference. ... Allegations concerning specific ‘knowledge’ of the prior art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge.”) (emphasis added); *In re Eynde*, 480 F.2d 1364 (C.C.P.A. 1973) (“[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. Facts constituting the state of the art in a patent case are normally subject to the possibility of rational disagreement among reasonable men, and **are not amenable to the taking of judicial or administrative notice.**”) (emphasis added); *In re Pardo*, 684 F.2d 912 (C.C.P.A. 1982) (“[T]his court will always **construe [the rule permitting judicial notice] narrowly** and will regard facts found in such manner with an eye toward narrowing the scope of any conclusions to be drawn therefrom. Assertions of technical facts in areas of esoteric technology **must always be supported by citation to some reference work** recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference.”) (emphasis added)

7.2. The References Do Not Disclose All the Limitations of Any of Claims 2-86, 89, 90, 92-98, 100, 101, 103, 104, 106-122, 127-130, 132, and 133

As discussed above, the Examiner’s rejections of all of the dependent claims (Claims 2-86, 89, 90, 92-98, 100, 101, 103, 104, 106-122, 127-130, 132, and 133) are based in part on unsupported general assertions of what was “notoriously well known and expected” before the time of Applicants’ invention. Applicants respectfully traverse the Examiner’s omnibus Official Notice of the recited features of all of the dependent claims (Claims 2-86, 89, 90, 92-98, 100, 101, 103, 104, 106-122, 127-130, 132, and 133). The cited Small reference does not support the Examiner’s broad assertions as to what was well known; the Examiner does not assert otherwise.

Applicants thus respectfully submit that the prior art of record does not disclose all of the limitations of any of dependent Claims 2-86, 89, 90, 92-98, 100, 101, 103, 104, 106-122, 127-130, 132, and 133.

7.3. No Motivation to Modify the Small Reference

Even if all of the recited features of all of the dependent claims were well known, which Applicants dispute, there is no suggestion or motivation in the prior art of record to modify the Small system in light of the Officially-Noticed subject matter, as proposed by the Examiner. As discussed above in Section 2 (page 33), the Examiner provides nothing beyond a mere statement that the claimed features would be advantageous. Small does not suggest why it would have been obvious to one of ordinary skill in the art to provide for any of the specific features of any of dependent Claims 2-86, 89, 90, 92-98, 100, 101, 103, 104, 106-122, 127-130, 132, and 133. Applicants respectfully submit that there is no suggestion in the prior art of record to modify the

Small system to provide for all of the features of dependent Claims 2-86, 89, 90, 92-98, 100, 101, 103, 104, 106-122, 127-130, 132, and 133.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness for any of the dependent claims (Claims 2-86, 89, 90, 92-98, 100, 101, 103, 104, 106-122, 127-130, 132, and 133).

Conclusion

It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

Please charge any fees that may be required for this Amendment to Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at [mdowns@walkerdigital.com](mailto:m downs@walkerdigital.com).

Respectfully submitted,



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